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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/935,287	08/22/2001	Joshua M. Kopelman	P23305-A USA	9679

7590 07/27/2005  
Synnestvedt & Lechner LLP  
2600 Aramark Tower  
1101 Market Street  
Philadelphia, PA 19107-2950

EXAMINER

O'CONNOR, GERALD J

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

09/935,287

**Applicant(s)**

Kopelman et al.

**Examiner**

O'Connor

**Art Unit**

3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE THREE MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on May 13, 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-13 and 21-32 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 21-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on August 22, 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Preliminary Remarks***

1. This Office action responds to the amendment and arguments filed by applicant on May 13, 2005 in reply to the previous Office action, mailed February 11, 2005.
2. The amendment of claims 1, 2, and 6-13, cancellation of claims 14-20, and addition of claims 21-32, in the reply filed by applicant on May 13, 2005, are hereby acknowledged.

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-13 and 21-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lalonde et al. (US 5,283,731).

Lalonde et al. discloses a computer-implemented method for listing an independent seller's good for sale using a CPU, a memory operatively connected to the CPU and a program stored in the memory and executable by the CPU for presenting the good for sale, the method

comprising: receiving from a seller information identifying a good, the information comprising a series of tones generated by depression of keys of a telephone; and presenting the good for sale, but the presentation of the good for sale in the pre-Internet method of Lalonde et al. is not on a website. However, using a website to present a good for sale is a well known, hence obvious, step to follow for those of ordinary skill in the art. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lalonde et al. so as to use a website for presenting the good for sale, as is well known to do, in order to present the good for sale to as wide an audience as possible by using the Internet, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claim 2, the method of Lalonde et al. includes that the series of tones navigates through a voice-prompt system.

Regarding claims 3-5, the method of Lalonde et al. includes that the telephone is a touch tone telephone and that the series of tones generated comprises tones generated by depressing the telephone's keys, but does not include that the tones generated indicate a sequence corresponding to an alphanumeric sequence of a universal product code (UPC), international standard book number (ISBN), or other standard identification code. However, standard product identification codes such as UPC and ISBN number are well known, hence obvious, to those of ordinary skill in the art, as a convenient means for identifying particular goods or products. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the

invention, to have modified the method of Lalonde et al. so as to allow a standard identification code such as UPC or ISBN to be entered in order to conveniently identify the good being or product being (re)sold, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 6 and 7, the method of Lalonde et al. includes retrieving information in real time relating to the good from a database; wherein the information retrieved is used to present the good for sale.

Regarding claim 8, the method of Lalonde et al. includes that the information identifying the good identifies a characteristic of the good in addition to an identity of the good.

Regarding claims 9 and 10, the method of Lalonde et al. includes receiving from the seller a selected sale price, but does not explicitly disclose anyone determining and recommending to the seller any recommended sales price. However, a seller soliciting recommendations for a recommended sales price when selling a used good is a well known, hence obvious, step to follow when selling a good. For example, checking the Blue Book value for a used car before determining an asking price for the car. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lalonde et al. so as to include someone/something determining and recommending to the seller a recommended sales price, so that the seller would be able to price the good in accordance with the market for the good, since so doing could be performed readily and easily

by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Regarding claims 11 and 12, the method of Lalonde et al. includes receiving a seller identification code which is recognizable in association with the seller, the seller identification code comprising tones generated by depressing the telephone's keys in a sequence corresponding to an alphanumeric sequence associated with the seller.

Regarding claim 13, the method of Lalonde et al. does not explicitly include that the seller identification code is a telephone number of the telephone from which the seller is calling, nor that the determination of a recommended sales price for the good comprises recognizing the telephone's telephone number by a caller identification technique. However, using a telephone number as an ID number for an account, determining a caller's telephone number by means of a caller ID technique, and recommending a sales price based on the seller's geographic area as determined by either of postal code or telephone number area code, are all well known, hence obvious, steps to perform when practicing such a method of selling goods. Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the method of Lalonde et al. so as to include that the seller identification code would be the telephone number of the telephone from which the seller was calling, and that the determination of a recommended sales price for the good comprises recognizing the telephone's telephone number by a caller identification technique, as is well known to do, in order to provide as accurate a recommendation as possible by taking into account the geographic area of the

seller, and since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

### *Response to Arguments*

5. Applicant's arguments filed May 13, 2005 have been fully considered but are not persuasive.

6. Regarding the argument that Lalonde et al. teach away "from use of an IVR to gather ad listing information," Lalonde et al. do not "teach away" from use of an IVR to gather ad listing information. Lalonde et al. explicitly disclose, as pointed out by applicant, the use of an IVR to gather ad listing information. Lalonde et al. merely point out that the automated embodiment is not their preferred embodiment, which is decidedly different from "teaching away." "Teaching away" would be if the reference disclosed that an automated system *could not* be used, not that an automated system *could* be used.

7. Regarding the argument that the Internet has a history dating back to approximately 1969, applicant is correct, the Internet *per se*, in one form or another, significantly pre-dates the applied prior art reference. The examiner's perhaps imprecise referral to the Lalonde et al. reference as being "pre-Internet" was referring to "pre-widespread-commercial-use of the Internet," not simply to its mere existence. Those of ordinary skill in the art are well aware that only a very small percentage of individuals, consumers, or households had any available access

to the Internet prior to 1995, and very few companies, other than large computer companies, such as Microsoft, had any Internet presence prior to 1995. For example, the examiner notes that none of *ebay.com*, *half.com*, or *synnlech.com* existed prior to 1995. So, though it would have been physically possible for Lalonde et al. to have put up a website to implement their invention, those of ordinary skill in the art would instantly recognize that so doing would have made little commercial sense, since it would have been difficult and expensive to do, and since only a very small percentage of individuals would have been able to see it.

8. Regarding the argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the knowledge generally available to one of ordinary skill in the art included the use of standard identification numbers to identify products, hence the motivation to use the pre-existing system of standardized identification numbers to conveniently and uniquely identify the product to be sold.

Furthermore, it is the finding of the examiner, as trier-of-fact, that it would have been within the ability of one of ordinary skill in the art to have used the system of Lalonde et al. with



a standardized number (UPC, ISBN, whatever) instead of any other part number, model number, or alphanumeric descriptor, with neither undue experimentation, nor risk of unexpected results. The point is well settled that the main test for the tenability of any conclusion of obviousness with respect to any proposed or hypothetical combination or modification of prior art knowledge is whether or not such a combination or modification could have been performed or implemented by any person of ordinary skill in the art, at the time of the invention, with neither undue experimentation, nor risk of unexpected results. See *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097, 231 USPQ 375, 379.

9. Regarding the argument that the examiner has asserted motivation to combine references based on common knowledge or common sense, the examiner has made no such assertion. Applicant is confusing the question of what is or is not prior art ("common knowledge" of prior art is okay) with the question of motivation to modify or combine ("common sense" to modify or combine not okay).

10. Regarding the argument that Lalonde et al. fail to disclose "retrieving information relating to a good, such as sale price information, from a database as part of the process of listing an item for sale," the argument is non-responsive to the applied rejection, since the rejection explicitly acknowledged and addressed the cited deficiency of the Lalonde et al. disclosure relative to the instant invention.

11. Regarding the argument that Lalonde et al. fail to disclose that a particular call is associated with a particular seller, Lalonde et al. indeed disclose identifying the seller that has called-in. See, in particular, element 152 of Figure 3, and the database 34 of sellers shown in Figure 1, neither of which could exist without a unique identifier for each seller.

12. Regarding the argument that Lalonde et al. fail to disclose “that the seller identification code is a telephone number of the telephone from which the seller is calling,” the argument is non-responsive to the applied rejection, since the rejection explicitly acknowledged and addressed the cited deficiency of the Lalonde et al. disclosure relative to the instant invention.

### *Conclusion*

13. The prior art made of record and not relied upon is considered pertinent to the disclosure.

14. Applicant’s amendment necessitated any new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be

calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

15. Any inquiry concerning this communication, or earlier communications, should be directed to the examiner, **Jerry O'Connor**, whose telephone number is **(571) 272-6787**, and whose facsimile number is **(571) 273-6787**.

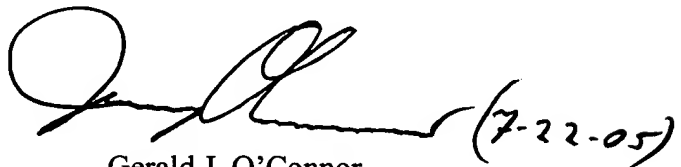
The examiner can normally be reached weekdays from 9:30 to 6:00.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Mr. Alexander Kalinowski, can be reached at **(571) 272-6771**.

Official replies to this Office action may be submitted by any *one* of fax, mail, or hand delivery. **Faxed replies are preferred and should be directed to (571) 273-8300**. Mailed replies should be addressed to "Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450." Hand delivered replies should be delivered to the "Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314."

GJOC

July 22, 2005

A handwritten signature in black ink, appearing to read "Gerald J. O'Connor", followed by the date "(7-22-05)" in parentheses.

Gerald J. O'Connor

Primary Examiner

Group Art Unit 3627